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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/693,189

10/23/2003

Takashi Inoue

P/16-346

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EXAMINER

SELBY, GEVELL V

ART UNIT

PAPER NUMBER

2622

MAIL DATE

DELIVERY MODE

07/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/693,189	INOUE, TAKASHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gevell Selby	2622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 8 is/are rejected.
- 7) ☒ Claim(s) 3 and 5-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/271,531.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments, see the amendment, filed 4/20/07, with respect to claims 1-7 have been fully considered and are persuasive. The 35 U.S.C. 102 and 103 rejections of claims 1-7 has been withdrawn.
2. Applicant's arguments filed 4/20/07 have been fully considered but they are not persuasive. The applicant submits the amendments to claims 1 and 2 overcome the 35 U.S.C. 101 rejections. The Examiner respectfully disagrees. The added limitations describing the positions of components in the camera would have been an obvious modification for one of ordinary skill in the art.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2622

4. Claim 8 is rejected on the ground of nonstatutory double patenting over claim 1 of U.S. Patent No. 6,714,248, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claim 8 in the instant application (application 2) recites the same limitations as claim 1 in application 1, However, claim 1 in application 1 recites the additional limitation of the relay board. Since claim 8 in application 2 are a broader recitation of claim 1 in application 1, it would have been obvious to modify claim 1 in application 1 to get claim 8 in application 2, in order to have a simpler embodiment of the invention.

5. Claims 1, 2, 4 are rejected on the ground of nonstatutory double patenting over claim 1 of U.S. Patent No. 6,714,248, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claims 1, 2, and 4 in the instant application (application 2) recites the same limitations as claim 1 in application , however, claims 1, 2, and 4 in application 1 recites the additional limitations describing the locations of the components. Since application 2 discloses the components claimed in the same positions as applicant 1 and there is no invention in shifting a location of a component, it would have been obvious to modify claim 1 in application 1 to get claims 1, 2, and 4 in application 2, in order to have a compact embodiment of the invention.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsukawa et al., US 5,867,744, in view of Toyofuku, US 6,181,380.**

In regard to claim 8, Matsukawa et al., US 5867,744, discloses an electrical image pickup apparatus comprising:

a generally flattened apparatus body (see figure 14, element 51) having a principal body plane that is generally aligned with a front side of the apparatus (see figure 8, element XII);

first and second electrical boards (see figure 15, elements 63 and 64) having electrical components mounted thereon and main body planes that extend substantially parallel to the principal body plane of the apparatus, the first and second electrical boards being spaced apart to create an internal space therebetween (see column 7, lines 41-45);

the lens barrel extending generally perpendicularly to the principal body plane (see figure 3, element 104);

one or more power supply batteries (see figure 15, elements 52 a and b) located in the internal space and situated at a predetermined position on a first side of the apparatus body, and arranged so that an axial direction thereof extends parallel to the main body planes of the first and second electrical boards (see column 6, lines 23-29: a vertical axis through the center of the batteries (52 a and b) is parallel to the sides of the electrical boards).

The Matsukawa reference does not disclose that the image pickup apparatus converts a subject image imaged by an image-taking optical system into an electrical signal using an imager provided behind a picture-taking lens barrel and a capacitor arranged between the lens barrel and an internal side wall of the body which is located on a side opposite the first side of the apparatus body, wherein an axial direction of the capacitor for strobe flashing is approximately parallel to the component sides of the electrical boards and perpendicular to a bottom surface of the apparatus body.

Toyofuku, US 6,181,380, discloses an image pickup apparatus converts a subject image imaged by an image-taking optical system into an electrical signal using an imager (see figure 5, element 62) provided behind a picture-taking lens unit (see figure 4, element 28 and column 7, 23-30) and a capacitor (see figure 4, element 36) arranged between the lens barrel (28) and an internal side wall of the body which is located on a side opposite the first side of the apparatus body, wherein an axial direction of the capacitor for strobe flashing is approximately parallel to the component sides of the

electrical boards and perpendicular to a bottom surface of the apparatus body (see column 6, lines 6-20).

It would have been obvious to one of ordinary skill in the art at the time of invention to have been motivated to modify Matsukawa et al., US 5867,744, in view of Toyofuku, US 6,181,380, to convert a subject image imaged by an image-taking optical system into an electrical signal using an imager provided behind a picture-taking lens barrel and a capacitor arranged between the lens barrel and an internal side wall of the body which is located on a side opposite the first side of the apparatus body, wherein an axial direction of the capacitor for strobe flashing is approximately parallel to the component sides of the electrical boards and perpendicular to a bottom surface of the apparatus body, in order to properly light the subject to obtain a better quality image and to be able to perform image processing on the images as well as allowing the data to be easily saved to a recording medium.

***Allowable Subject Matter***

8. Claims 3, 5, 6, and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gevell Selby whose telephone number is 571-272-7369. The examiner can normally be reached on 8:00 A.M. - 5:30 PM (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on 571-272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

gvs



LIN YE  
SPE. ART UNIT 2622